

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN JOSEPH AMELL, HARVEY GENE KIEL, RAYMOND
FRANCIS ROMON, SHOJI OKIMOTO and TOSHIO SHIMIZU

Appeal No. 1999-2637
Application 08/813,864

ON BRIEF

Before JERRY SMITH, FLEMING, and LALL, ***Administrative Patent Judges.***

FLEMING, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-21, all the claims pending in the instant application.

The instant invention discloses a method and apparatus for supporting multiple display sessions through a single address on a non-programmable-terminal (NPT) attached to a host computer by a work station controller (WSC). Appellants' Specification (Specification), page 2, line 36, to page 3, lines 1-4. Multiple display sessions share a single address or use shared addressing. Specification, page 5, lines 11-13. The invention introduces a concept called focus. Specification, page 5, lines 14-15. At any given time, only one of the multiple display sessions has the focus. The display session which has the focus communicates with the WSC as if the session were the single display session available on the shared address. Specification, page 5, lines 15-19. Any session which does not have the focus is invisible from a communication viewpoint until the focus is passed to the session. Specification, page 5, lines 31-33. The focus is passed from one session to another by a twinaxial focus change command sent from the WSC to the NPT. If the WSC needs to communicate with a second session which does not have the focus, the WSC has to send the new twinaxial command beforehand so that the second session gets the focus.

Specification, page 5, line 33, to page 6, line 1. NPT may have one active session for the user interface, or the session the user is working with which does not have the focus, and a different session having the focus simultaneously communicating with the host processor. Specification, page 6, lines 2-6. An input from the operator via the keyboard and/or mouse through the user active session is not passed to the WSC until the active user interface session has the focus.

Specification, page 6, lines 9-12. If the input is made in a session which does not have the focus, the input is queued and the NPT requests the WSC to change the focus through the session which currently has the focus. Specification, page 6, lines 12-15. Upon receipt of the change focus request, the WSC will send the twinaxial change focus command to pass the focus to the active user interface session; and the NPT informs the WSC of the input which has been queued while the session did not have the focus. Specification, page 6, lines 15-20.

Representative claim 1 reads as follows:

1. Apparatus for supporting multiple display sessions through a single address on a non-programmable terminal (NPT), the NPT

attached to a host computer by a work station controller (WSC), the improvement in the WSC comprising:

means for enabling shared addressing of multiple display sessions through the single address on the NPT; said shared addressing of multiple display sessions on the NPT enabling means including means for checking for a shared addressing request in set-up from the NPT and means responsive to an identified shared addressing request in set-up from the NPT for setting a shared addressing flag; and

focus change command means for identifying a focus change request from the NPT for a requested display session of the multiple display sessions sharing the single address on the NPT and for changing focus to said requested display session of the multiple display sessions; only one of the multiple display sessions having the focus at any time.

In rejecting Appellants' claims, the Examiner relies on the following references:

Ashkin et al. (Ashkin) 1990	4,918,598	Apr. 17,
Clark et al. (Clark) 1994	5,359,660	Oct. 25,
Marisetty et al. (Marisetty) 16, 1998	5,768,598	Jun.
Botterill et al. (Botterill) 28, 1997	5,682,169	Oct.

Claims 1, 17, and 19 stand rejected under 35 U.S.C. § 103(a) as obvious over Botterill and Marisetty. Claims 2, 5-8, 11-16, 18, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as obvious over Botterill, Marisetty, and Ashkin. Claims 3, 4, 9, and 10 stand rejected under 35 U.S.C. § 103(a)

as obvious over Botterill, Marisetty, and Clark. Rather than repeat the arguments of the Appellants and Examiner, we refer the reader to the Appellants' Brief¹ and Examiner's Answer² for the respective details thereof.

OPINION

With full consideration being given the subject matter on appeal, the Examiner's rejection and the arguments of Appellants and Examiner, for the reasons stated infra, we will reverse the Examiner's rejection of claims 1, 17, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Botterill and Marisetty. We will reverse the Examiner's rejection of claims 2, 5-8, 11-16, 18, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Botterill, Marisetty and Ashkin. We will also reverse the Examiner's rejection of claims 3, 4,

¹ Appellants filed an Appeal Brief for Applicants on August 21, 1998. Appellants filed a Supplemental Appeal Brief for Applicants ("Brief") on November 20, 1998.

² The Examiner, in response to Appellants' Brief, mailed an Examiner's Answer on May 14, 1999.

9,³ and 10 under 35 U.S.C. § 103(a) as being unpatentable over Botterill, Marisetty and Clark.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788 ("After a prima facie case of obviousness has been established, the burden of going forward shifts to the applicant.").

³ Claims 9, 10, and 13 depend from claim 7. Therefore, the proper rejection should be claims 9, 10, and 13 rejected under 35 U.S.C. § 103(a) as being unpatentable over Botterill, Marisetty, Ashkin and Clark.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. **See *In re Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444 ("In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the evidence and arguments."). With these principles in mind, we commence review of the pertinent evidence and arguments of Appellants and Examiner.

The Appellants assert that Botterill provides no suggestion of any means for enabling shared addressing of multiple display sessions through the single address on the NPT, nor of any focus change command means for identifying a focus change request from the NPT for a requested display session of the multiple display sessions sharing the single address on the NPT and for changing focus. Brief at page 18, lines 15-21. Additionally, the Appellants state that the Marisetty prior art provides no suggestion of means for enabling shared addressing of multiple display sessions on the NPT and focus change command means for identifying a focus change request from the NPT for a requested display session of multiple display sessions sharing the single address on the

NPT and for changing focus to the requested display session. Brief at page 19, lines 1-8. Appellants finally conclude that there is neither an express nor an implied suggestion in Botterill and Marisetty which would have motivated the artisan to modify the Botterill reference in a manner which would result in that which is claimed. Brief at page 20, lines 19-23.

The Examiner responds that Marisetty teaches a means for enabling and sending a shared addressing request. Examiner's Answer, page 5, line 18, to page 6, line 8. The Examiner also asserts that Marisetty discloses a means for checking a shared addressing request and for identifying shared addressing request in set-up from the NPT for setting a shared addressing flag. Examiner's Answer, page 6, lines 2-4. Additionally, the Examiner states that Marisetty teaches a means for enabling shared addressing. The Examiner additionally contends that Marisetty teaches a means for changing focus. Examiner's Answer, page 6, lines 10-11.

Reviewing Botterill, we do not find that Botterill discloses Appellants' claimed "apparatus for supporting

multiple display sessions through a single address on a non-programmable-terminal (NPT)." Moreover, we do not find that Botterill teaches or suggests only "one of the multiple display sessions having the focus at any time."

In Botterill, we find that the only relevant teaching to Appellants' invention discloses the transfer of information from a workstation controller (WSC) to a plurality of remote non-programmable-terminals. Botterill, column 5, lines 51-54. However, we do not find that Botterill teaches or suggests Appellants' claimed invention, and in particular, the limitations that require "shared addressing of multiple display sessions through the single address on the NPT" and "only one of multiple display sessions having the focus at any time."

In reviewing the Marisetty prior art, we find that Marisetty does not supply or suggest at least the limitations of "shared addressing of multiple display sessions through the single address on the NPT" and "only one of multiple display sessions having the focus at any time." Nothing in Marisetty teaches or suggests enabling multiple display sessions through a single address on the NPT. Further, we find that nothing in

Marisetty teaches or suggests one of the multiple display sessions having the focus at any one time.

It is the burden of the Examiner to establish why one of ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). In this case, the Examiner has failed to show, and we find no evidence of, any teaching or suggestion in Botterill or Marisetty of Appellants' claimed limitations, and in particular, the limitations of "shared addressing of multiple display sessions through the single address on the NPT" and "only one of the multiple display sessions having the focus at any time." We further find no implicit or explicit reason to plausibly combine the teachings of Botterill and Marisetty in a manner that suggests or would make obvious Appellants' claimed invention.

Because neither Botterill nor Marisetty, alone or in combination, teaches or suggests Appellants' claimed limitations, we conclude that the Examiner has failed to establish a

prima facie case of obviousness. Accordingly, we reverse the Examiner's rejection of claim 1 as obvious over Botterill and Marisetty.

Turning next to independent claim 17, we note that this claim incorporates the limitations of "shared addressing of multiple display sessions through the single address on the NPT" and "only one of the multiple display sessions on the NPT having the focus at any time." Having already determined that neither Botterill nor Marisetty, alone or in combination, teaches these claimed limitations, we conclude, without further review, that the Examiner has failed to establish a ***prima facie*** case of obviousness with respect to independent claim 17. Accordingly, we reverse the Examiner's rejection of claim 17 as obvious over Botterill and Marisetty.

Reviewing now independent claim 7, we note that this claim also incorporates the limitations of "shared addressing of multiple display sessions through the single address on the NPT" and "only one of the multiple display sessions having the focus at any time." We have already determined that neither

Botterill nor Marisetty, alone or in combination, teaches these claimed limitations. We further determine that the Ashkin prior art does not close the gap by teaching or suggesting these claimed limitations.

We find that Ashkin discloses a method of transferring data between a plurality of peripheral devices and a host computer. Ashkin, column 2, lines 35-55. Nothing in Ashkin teaches or suggests the limitation of enabling "multiple display sessions through the single address on the NPT." Further, we find that nothing in Ashkin teaches or suggests the limitation of "only one of the multiple display sessions having the focus at any one time." Therefore, we conclusively determine that no implicit or explicit reason exists to plausibly combine the teachings of Botterill, Marisetty and Ashkin. Accordingly, we find that the Examiner has failed to establish a ***prima facie*** case of obviousness with respect to claim 7. In so finding, we reverse the Examiner's rejection of independent claim 7 as obvious over Botterill, Marisetty and Ashkin.

Turning next to independent claim 14, we find that this claim likewise incorporates the limitations of "shared addressing of multiple display sessions through the single address on the NPT" and "only one of the multiple display sessions having the focus at any time." Having previously determined that neither Botterill, Marisetty nor Ashkin, either alone or in combination, teaches these claimed limitations, we reverse the Examiner's rejection of claim 14 as obvious over Botterill, Marisetty and Ashkin.

Dependent claims 3 and 4 incorporate the limitations of independent claim 1. Dependent claims 9 and 10 incorporate the limitations of independent claim 7. We have already established that neither Botterill nor Marisetty teaches or suggests the limitations of claims 1 or 7, specifically the "shared addressing of multiple display sessions through the single address on the NPT" and "only one of the multiple display sessions having the focus at any time."

We further find that Clark does not close the gap by teaching or suggesting these claimed limitations. Clark discloses a method and system for remotely securing networked computers. Clark, column 1, lines 34-36. The network

includes plural individual data processing systems, computers or workstations which are connected together in a local area network. Clark, column 2, lines 26-29. Nothing in Clark teaches or suggests the limitation of enabling "multiple display sessions through the single address on the NPT." Further, we find that nothing in Clark teaches or suggests the limitation of "only one of the multiple display sessions having the focus at any one time." Therefore, we conclusively determine that no implicit or explicit reason exists to plausibly combine the teachings of Botterill, Marisetty and Clark. Because we find that neither Botterill, Marisetty, nor Clark, either alone or in combination, teaches or suggests Appellants' claimed limitations, we conclude that the Examiner has failed to establish a ***prima facie*** case of obviousness. Accordingly, we reverse the Examiner's rejection of dependent claims 3, 4, 9, and 10 as obvious over Botterill, Marisetty, and Clark.

The Federal Circuit instructs that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the

prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "such a suggestion may" come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." **Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976)(considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or

suggestions of the invention." **Para-Ordnance**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W.L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. In addition, our reviewing court requires the Patent Trademark Office to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Based on the foregoing, we conclude that the Examiner has failed to establish a **prima facie** case of obviousness with respect to claims 1-21. In summary, we reverse the Examiner's rejection of claims 1, 17, and 19 under 35 U.S.C. § 103(a) as unpatentable over Botterill and Marisetty; we reverse the Examiner's rejection of claims 2, 5-8, 11-16, 18, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over Botterill, Marisetty, and Ashkin. We also reverse the Examiner's rejection of claims 3, 4, 9, and 10 under 35 U.S.C. § 103(a) as unpatentable over Botterill, Marisetty, and Clark.

REVERSED

Appeal No. 1999-2637
Application 08/813,864

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